

ESTTA Tracking number: **ESTTA438636**

Filing date: **10/31/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91201726
Party	Defendant Bi-Silque-Artigos Para Casa e Escritorio , S.A.
Correspondence Address	DAVID EHRLICH FROSS ZELNICK LEHRMAN & ZISSU PC 866 UNITED NATIONS PLZ NEW YORK, NY 10017-1822 UNITED STATES
Submission	Motion to Suspend for Civil Action
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Date	10/31/2011
Attachments	Motion to Suspend (w- Exhibits) (F0903033).PDF (25 pages)(1046131 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Application Serial No. 77/405,947

Filed: February 26, 2008

Mark: EARTH-IT

Published: May 24, 2011

3M Company,

Opposer,

vs.

BI-SILQUE-ARTIGOS PARA CASA E
ESCRITORIO, S.A.,

Applicant.

Opposition No. 91/201,726

**MOTION TO SUSPEND OPPOSITION
PENDING RESOLUTION OF CIVIL ACTION**

Applicant Bi-Silque-Artigos Para Casa E Escritorio, S.A. ("Applicant"), hereby moves for an order suspending this opposition proceeding pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a) until a final determination has been made in a civil action now pending between the same parties concerning the same mark in the United States District Court for the District of Minnesota, Civil Action No. 0:11-cv-02445-PAM-JSM (the "Civil Action").

On August 25, 2011, Opposer in this action and Plaintiff in the Civil Action, 3M Company, filed the Civil Action against Applicant and its wholly owned U.S. subsidiary asserting, among other claims, that Applicant's use of the mark EARTH-IT, the very mark at issue in the Opposition, and NOTE-IT infringed on Opposer's POST-IT mark, the very mark Opposer relies on in the Opposition. As part of the relief sought in the Civil Action, Opposer requested that Applicant be prohibited from making any use of the EARTH-IT mark. A copy of the Complaint in the Civil Action is attached as Exhibit A. The Opposition and the Civil Action mirror each other in their allegations. Both set forth the identical description of 3M and its

POST-IT mark. Compare Civil Action ¶¶ 8-9 to the Notice of Opposition (attached as Exhibit B) ¶ 1. In both the Civil Action and the Opposition, 3M alleges that it has common law rights in the POST-IT mark, and that the POST-IT mark is famous. Compare Civil Action ¶¶ 11-15 to Notice of Opposition ¶¶ 1-2. In both the Civil Action and the Opposition, 3M relies on the identical federally-registered rights in the POST-IT mark. Compare Civil Action ¶ 16 to Notice of Opposition ¶ 3. In both the Civil Action and the Opposition, 3M alleges that Applicant's EARTH-IT mark is used in connection with goods that are directly competitive with these goods for which Opposer uses its POST-IT mark, that Applicant's good travel or will travel in the same channels of trade as Opposer's goods, that Applicant's mark so resembles Opposer's POST-IT mark as to be likely to cause confusion, and that Applicant's mark is likely to cause dilution by blurring of Opposer's mark. Compare Civil Action ¶¶ 18-54 to Notice of Opposition ¶¶ 9-15. And both the Civil Action and the Opposition, 3M claims that Applicant's mark is inconsistent with Opposer's rights and is damaging to Opposer. Compare Civil Action ¶ 42 to Notice of Opposition ¶ 16.

Pursuant to 37 C.F.R. § 2.117(a), "[w]henver it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action . . . which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action" As the TTAB Manual of Procedure recognizes, "Most commonly, a request to suspend pending the outcome of another proceeding seeks suspension because of a civil action pending between the parties in a federal district court." *See also* TBMP § 510.02(a). Here, Opposer and Applicant, as well as Applicant's wholly-owned U.S. subsidiary, are involved in such a "civil action" pending in the District Court in Minnesota. Here, the Civil Action concerns two marks, one of which is the very mark at issue in this Opposition. Resolution of the Civil Action will directly bear on and may be dispositive of this Opposition proceeding. Indeed, the Board routinely grants motions to suspend opposition

proceedings pending the outcome of a pending civil action where issues of trademark infringement and unfair competition are raised on the grounds that such actions may be dispositive of the inter partes proceedings. TBMP § 510.02(a); *see also Other Tel. Co. v. Conn. Nat'l Tel. Co.*, 181 U.S.P.Q. 125, 126 (T.T.A.B. 1974) (suspending opposition proceeding during pendency of district court action where Opposer was seeking to enjoin Applicant from using the mark at issue in the opposition proceeding) and cases cited herein.

Here, both the Civil Action and the Opposition relate directly to whether there is likelihood of confusion between the POST-IT mark of Opposer (and Plaintiff) and the EARTH-IT mark of Applicant (and Defendant). These marks are at the center of both the Civil Action and the Opposition. A decision by the federal district court that there is no likelihood of confusion, if not determinative of the issues raised in the Opposition, will certainly bear on those issues. The observations in the seminal case *Squirrel Brand Co. v. Barnard Nut Co.*, 101 U.S.P.Q. 340 at 340 (Comm'r 1954) are directly applicable here:

Although the ultimate finding of the tribunals of the Patent Office in proceedings such as these is the right of an applicant to register, nevertheless there must be a finding of the right to use in commerce before that ultimate finding can be made. The Court, in the civil action, will necessarily determine this preliminary question of the right to use, and that determination will form the basis of the ultimate finding of the Office.

Simply stated, if the Court concludes that the defendant (applicant) has no right to use its mark, it has no right to register . . .

Conversely if there is a right to use there also is the right to register. Since Opposer has asked the federal district court to determine whether Applicant and its wholly owned U.S. company can use EARTH-IT, the very mark at issue in the Opposition, a suspension is appropriate pending a final determination in the Civil Action.

The procedural history of the Opposition shows that there will be no harm to Opposer if this motion to suspend is granted. This motion is being filed contemporaneously with the

Applicant's Answer. The Opposition is in its infancy, with neither Party having served initial disclosures, neither party having taken discovery and neither party having devoted any significant resources to the Opposition. Further, Opposer cannot claim that suspension of this proceeding will somehow delay a decision on whether Applicant will commence use of the mark at issue, since, as evidenced by the Civil Action, the EARTH-IT mark is being used and in fact has been used for approximately 3 years in the U.S. without any evidence of actual confusion.

CONCLUSION

Since there is no good cause for opposing the motion to suspend and given that the Trademark Rules of Practice specifically recognize the appropriateness of suspending opposition proceedings for the very reasons that exist in this case, Applicant respectfully requests that in the interest of judicial economy the Board suspend the Opposition proceeding pending final resolution of the Civil Action between the parties.

Dated: New York, New York
October 31, 2011

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 
Barbara A. Solomon

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*Attorneys for Applicant Bi-Silque-Artigos Para
Casa E Escritorio, S.A.,*

EXHIBIT A

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA

3M COMPANY,	§	
	§	
Plaintiff,	§	
	§	CIVIL ACTION NO. _____
v.	§	
	§	
BI-SILQUE-ARTIGOS PARA CASA E	§	
ESCRITORIO, S.A. and	§	
BI-SILQUE VISUAL	§	JURY DEMAND
COMMUNICATION PRODUCTS,	§	
INC.,	§	
	§	
Defendants.	§	

**COMPLAINT FOR TRADEMARK INFRINGEMENT, DILUTION
UNFAIR COMPETITION, AND UNJUST ENRICHMENT**

3M Company ("3M"), appearing through its undersigned counsel, alleges as follows:

PARTIES

1. 3M is a Delaware corporation having its principal place of business at 3M Center, 2501 Hudson Road, St. Paul, Minnesota 55144.

2. Bi-Silque-Artigos Para Casa e Escritorio, S.A. ("Bi-Silque") is a Portuguese corporation with a principal place of business at Avenida Da Praia, Esmoriz, 3880 Ovar, Portugal.

3. Bi-Silque Visual Communication Products, Inc. ("Bi-Silque Visual") is a Florida corporation having its principal place of business at 4010 Oak Circle, Suite 200, Boca Raton, FL 33431. Bi-Silque Visual is a wholly owned subsidiary of Bi-Silque.

4. Bi-Silque and Bi-Silque Visual are collectively referred to herein as “Defendants.”

NATURE OF THIS ACTION; JURISDICTION OF THE COURT

5. This is an action for trademark infringement, dilution, and unfair competition under the Trademark Act of 1946, as amended, 15 U.S.C. § 1051 *et seq.* (“Lanham Act”); for deceptive trade practices arising under the Minnesota Deceptive Trade Practices Act, Minn. Stat. § 325D.44 *et seq.*; for unlawful trade practices under the Minnesota Unlawful Trade Practices Act, Minn. Stat. § 325D.09 *et seq.*; for dilution under the Minnesota anti-dilution statutes, Minn. Stat. § 333.285 *et seq.*; for trademark infringement and unfair competition under the common law of Minnesota and other states where Defendants conduct business and have committed the acts complained of herein; and for unjust enrichment.

6. This Court has jurisdiction over the subject matter of this action under 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a) and 1338(b), and has supplemental jurisdiction under 28 U.S.C. § 1367(a) over 3M’s claims under state law.

7. The matter in controversy in this action exceeds the sum or value of \$75,000, exclusive of interest and costs, and is between citizens of different states and a foreign state. Therefore, this Court also has subject matter jurisdiction pursuant to 28 U.S.C. § 1332.

3M’S USE AND REGISTRATION OF THE MARK POST-IT

8. 3M develops and markets innovative products and solutions, including many consumer and office products, serving a diverse field of customers.

9. 3M introduced the revolutionary POST-IT brand of repositionable notes (“POST-IT Notes”) and adhesive-backed paper approximately thirty years ago. Since that time, 3M has continuously used the mark POST-IT (the “POST-IT Mark”) in connection with a variety of highly successful stationery and office-related products, including, without limitation, repositionable notes, adhesive backed easel pads and paper, bulletin boards, dry-erase boards, and combination boards comprising in part dry-erase boards and in part bulletin boards.

10. 3M is committed to sustainable practices in connection with its formulation of POST-IT products. This includes, but is not limited to, the use of recycled paper in many of 3M’s POST-IT products, and the fact that all of its POST-IT paper products are themselves recyclable. In addition, 3M’s POST-IT brand notes and easel pads have the Sustainable Forestry Initiative (SFI) Chain of Custody Certification, certifying that the paper used comes from well-managed forests where trees harvested for paper are replanted. 3M’s packaging and marketing of its POST-IT products have called attention to these and other sustainability efforts by 3M.

11. The POST-IT Mark is inherently distinctive and serves to identify and indicate the source of 3M’s products and services to the consuming public.

12. As a result of 3M’s long and extensive use and promotion of the POST-IT Mark and the many high-quality products sold under the mark, POST-IT is a leading brand in the market for office products and supplies, and also is one of the most famous brands in the United States. *See Minnesota Min. & Mfg. Co. v. Taylor*, 21 F. Supp. 2d 1003, 1005 (D. Minn. 1998) (finding POST-IT mark famous).

13. Use of 3M's POST-IT brand products by consumers is extremely widespread, including in the home, office, and promotional markets. 3M's POST-IT products are promoted and available for purchase online, including directly from 3M through its websites (including 3M.com and Post-it.com), third-party websites such as Amazon.com, as well as in, and on the websites of, leading national office supply stores (Office Depot, OfficeMax, Staples); pharmacies (CVS, Rite Aid, Walgreens); and general retailers (Target, Wal-Mart).

14. As a result of 3M's long use and promotion, 3M has acquired valuable common law rights in the POST-IT Mark.

15. The POST-IT Mark has become famous, including in Minnesota.

16. In addition to its extensive common law rights, 3M has registered the POST-IT Mark on the Principal Register of the United States Patent and Trademark Office in accordance with federal law. 3M owns numerous U.S. registrations, many of which are incontestable, for its famous mark POST-IT for numerous goods. These registrations include, but are not limited to, the valid and subsisting registrations shown in the following chart, each of which is incontestable except Reg. No. 3,168,105:

Mark	Registration Number	Date Issued	Goods
POST-IT	1046353	8/17/76	Paper and cardboard sheet material having adhesive coating on both sides thereof for attachment to walls or other vertical surfaces to hold displays or other messages in place
POST-IT	1198694	6/22/82	Stationery notes containing adhesive on one side for attachment to surfaces
POST-IT	1208297	9/14/82	Trays for holding stationery notes

Mark	Registration Number	Date Issued	Goods
POST-IT	1284295	7/3/84	Adhesive tape for home and office use
POST-IT	1935381	11/14/95	Adhesive backed easel paper and easel pads
POST-IT	2736421	7/15/03	Stationery notes and note pads containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; cover-up tape for paper; tape flags; printed note forms; printed notes featuring messages, pictures or ornamental designs; adhesive-backed easel paper and easel pads; bulletin boards; glue sticks for stationery or office use; and paper and cardboard sheet material having adhesive coatings on both sides for attachment to walls or other surfaces to hold displays or other messages in place
POST-IT	3168105	11/7/06	Stationery notes containing adhesive on one side for attachment to surfaces; printed notes featuring messages, pictures or ornamental designs; note pads, business forms, index cards, index tabs, easel paper, easel pads, sketch pads, art pads, banners of paper, page markers, bookmarks and recipe cards containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; labeling tape; cover-up tape for paper; correcting tape for type; tape flags; easels; display and message boards, adhesive backed strips and geometrical shapes made from cardboard for attachment to surfaces; dry erase writing boards and writing surfaces; holders for stationery notes, notepads and tape flags; dispensers for tape flags and stationery notes for stationery use; ball point pens and highlighter pens containing tape flags; photo paper

True and correct copies of these registrations are attached as Exhibit A.

DEFENDANTS' UNLAWFUL ACTIVITIES

17. Defendants manufacture and sell a variety of home and office supplies.

18. Defendants sell office products under the marks NOTE-IT and EARTH-IT (“Defendants’ Marks”). For example, Defendants use the mark NOTE-IT in connection with dry-erase boards and combination boards comprising in part dry-erase boards and in part bulletin boards. Defendants use the mark EARTH-IT in connection with repositionable adhesive-backed easel pads and bulletin boards, among other products. (Defendants’ products sold under the marks NOTE-IT and EARTH-IT are referred to herein as “Defendants’ Products”).

19. Defendants’ Marks are confusingly similar to 3M’s famous POST-IT Mark. In particular, consumers are likely to associate the mark NOTE-IT with POST-IT given 3M’s extensive use of the term “Notes” with its POST-IT Mark in connection with its ubiquitous POST-IT Notes products. Similarly, consumers are likely to associate the mark EARTH-IT with POST-IT, particularly given 3M’s conservation efforts in connection with its POST-IT products such as those discussed above.

20. Defendants’ Products are sold in direct competition with products sold by 3M under its POST-IT Mark.

21. Defendants’ Products are promoted and available for purchase online, including from third-party websites such as Amazon.com, as well as in, and on the websites of, leading retailers including Office Depot, Target, and Wal-Mart.

22. Defendants' Products travel through the same channels of trade as competing products sold by 3M under its POST-IT Mark.

23. Defendants are using Defendants' Marks in commerce, and in this judicial district.

24. Defendants began using Defendants' Marks long after 3M began using and registered the POST-IT Mark and long after the POST-IT Mark became famous.

25. Defendants' use of Defendants' Marks in this manner is not authorized or endorsed by 3M in any way.

**EFFECT OF DEFENDANTS' ACTIVITIES ON 3M AND THE CONSUMING
PUBLIC**

26. Defendants' unauthorized use of Defendants' Marks in the manner described above is likely to cause confusion, to cause mistake, and/or to deceive customers and potential customers of the parties, at least as to some affiliation, connection, or association between Defendants and 3M or its POST-IT brand, or as to the origin, sponsorship, or approval of Defendants' Products by 3M or its POST-IT brand.

27. Defendants' unauthorized use of Defendants' Marks falsely designates the origin of Defendants' Products, and falsely and misleadingly describes and represents facts with respect to Defendants and their products and services.

28. Defendants' unauthorized use of Defendants' Marks enables Defendants to trade on and receive the benefit of goodwill built up at great labor and expense by 3M over many years, and to gain acceptance for their products and services not solely on

their own merits, but on the reputation and goodwill of 3M, 3M's POST-IT Mark, and 3M's products and services.

29. Defendants' unauthorized use of Defendants' Marks is likely to cause dilution of 3M's famous POST-IT Mark.

30. Defendants' unauthorized use of Defendants' Marks unjustly enriches Defendants at 3M's expense.

31. Defendants' unauthorized use of Defendants' Marks removes from 3M the ability to control the nature and quality of products and services provided under the POST-IT Mark, and places the valuable reputation and goodwill of 3M in the hands of Defendants, over whom 3M has no control.

32. Unless these acts of Defendants are restrained by this Court, they will continue, and they will continue to cause irreparable injury to 3M and to the public for which there is no adequate remedy at law.

COUNT I: FEDERAL TRADEMARK INFRINGEMENT

33. 3M repeats the allegations above as if fully set forth herein.

34. The acts of Defendants complained of herein constitute infringement of 3M's federally registered POST-IT Mark in violation of 15 U.S.C. § 1114(1).

35. Defendants' acts complained of herein have been malicious, fraudulent, deliberate, willful, intentional, or in bad faith, with full knowledge and conscious disregard of 3M's rights in the POST-IT Mark and with intent to cause confusion and to trade on 3M's vast goodwill in the POST-IT Mark. In view of the egregious nature of

Defendants' infringement, this is an exceptional case within the meaning of 15 U.S.C. § 1117(a).

**COUNT II: FEDERAL UNFAIR COMPETITION AND
FALSE DESIGNATION OF ORIGIN**

36. 3M repeats the allegations above as if fully set forth herein.

37. The acts of Defendants complained of herein constitute unfair competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

COUNT III: FEDERAL DILUTION

38. 3M repeats the allegations above as if fully set forth herein

39. The acts of Defendants complained of herein constitute trademark dilution in violation of 15 U.S.C. § 1125(c).

40. Defendants have willfully intended to trade on the recognition of 3M's famous POST-IT Mark, entitling 3M to the additional remedies for trademark dilution set forth in 15 U.S.C. § 1125(c)(5).

COUNT IV: DECEPTIVE TRADE PRACTICES

41. 3M repeats the allegations above as if fully set forth herein.

42. The acts of Defendants complained of herein constitute deceptive trade practices in violation of Minn. Stat. § 325D.44 *et seq.*

43. Pursuant to Minn. Stat. § 325D.45, 3M is entitled to recover its costs and attorneys' fees.

COUNT V: UNLAWFUL TRADE PRACTICES

44. 3M repeats the allegations above as if fully set forth herein.

45. The acts of Defendants complained of herein constitute unlawful trade practices in violation of Minn. Stat. § 325D.09 *et seq.*

46. Pursuant to Minn. Stat. § 325D.15 and Minn. Stat. § 8.31(3a), 3M is entitled to recover its costs, disbursements, costs of investigation, and reasonable attorneys' fees.

COUNT VI: DILUTION UNDER STATE LAW

47. 3M repeats the allegations above as if fully set forth herein.

48. The acts of Defendants complained of herein constitute trademark dilution in violation of the anti-dilution statutes of Minnesota, Minn. Stat. § 333.285 and the other states in which Defendants have committed the acts complained of herein.

COUNT VII: TRADEMARK AND TRADE NAME INFRINGEMENT UNDER THE COMMON LAW OF MINNESOTA AND OTHER STATES

49. 3M repeats the allegations above as if fully set forth herein.

50. The acts of Defendants complained of herein constitute trademark infringement in violation of the common law of Minnesota and the other states in which Defendants have committed the acts complained of herein.

COUNT VIII: UNFAIR COMPETITION UNDER THE COMMON LAW OF MINNESOTA AND OTHER STATES

51. 3M repeats the allegations above as if fully set forth herein.

52. The acts of Defendants complained of herein constitute unfair competition in violation of the common law of Minnesota and the other states in which Defendants have committed the acts complained of herein.

COUNT IX: UNJUST ENRICHMENT

53. 3M repeats the allegations above as if fully set forth herein.

54. The acts of Defendants complained of herein constitute unjust enrichment of Defendants at 3M's expense.

DEMAND FOR RELIEF

WHEREFORE, 3M demands that:

(a) Defendants, their officers, agents, servants, employees, and attorneys, and all other persons who are in active concert or participation with any of them, be permanently enjoined and restrained from using Defendants' Marks, and any other mark that is not at least a safe distance away from, or otherwise confusingly similar to or likely to cause dilution of 3M's POST-IT Mark, and from any attempt to retain any part of the goodwill misappropriated from 3M;

(b) Defendants be ordered to file with this Court and to serve upon 3M, within thirty (30) days after the entry and service on Defendants of an injunction, a report in writing and under oath setting forth in detail the manner and form in which Defendants have complied with the injunction;

(c) 3M recover all damages it has sustained as a result of Defendants' activities and that said damages be trebled;

(d) An accounting be directed to determine Defendants' profits resulting from their activities and that such profits be paid over to 3M, increased as the Court finds to be just under the circumstances of this case;

(e) 3M recover its reasonable attorney fees;

(f) 3M recover its costs of this action and prejudgment and post-judgment interest; and

(g) 3M recover such other relief as the Court may deem appropriate.

DEMAND FOR JURY TRIAL

Pursuant to FED. R. CIV. P. 38, 3M demands a jury trial on all issues in this case triable of right by a jury.

Respectfully submitted,

DATED: August 25, 2010

s/Heather J. Kliebenstein
Heather J. Kliebenstein (MN Bar #0320936)
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**ATTORNEYS FOR PLAINTIFF 3M
COMPANY**

EXHIBIT B

In Re Serial No. 77/405,947
Filed: February 26, 2008
Mark: **EARTH-IT**
Published: May 24, 2011

Applicant.

[illegible]

1

Opposer's POST-IT mark is among the most famous marks in the United States, with very high brand awareness levels.

2. Opposer's POST-IT mark is famous within the meaning of 15 U.S.C. § 1125(c)(2)(A). See *Minnesota Min. & Mfg. Co. v. Taylor*, 21 F. Supp. 2d 1003, 1005, 48 USPQ2d 1701, 1702 (D. Minn. 1998) (finding POST-IT mark famous).

3. In addition to its extensive common-law rights, Opposer is the owner of numerous United States Trademark Registrations for its POST-IT mark. Opposer's registrations include, but are not limited to, those shown in the following chart:

Registration Number	Date Issued	Goods (Class 16)
1046353	8/17/76	Paper and cardboard sheet material having adhesive coating on both sides thereof for attachment to walls or other vertical surfaces to hold displays or other messages in place
1198694	6/22/82	Stationery notes containing adhesive on one side for attachment to surfaces
1208297	9/14/82	Trays for holding stationery notes
1284295	7/3/84	Adhesive tape for home and office use
1935381	11/14/95	Adhesive backed easel paper and easel pads
2736421	7/15/03	Stationery notes and note pads containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; cover-up tape for paper; tape flags; printed note forms; printed notes featuring messages, pictures or ornamental designs; adhesive-backed easel paper and easel pads; bulletin boards; and paper and cardboard sheet material having adhesive coatings on both sides for attachment to walls or other surfaces to hold displays or other messages in place
3168105	11/7/06	Stationery notes containing adhesive on one side for attachment to surfaces; printed notes featuring messages, pictures or ornamental designs; note pads, business forms, index cards, index tabs, easel paper, easel pads, sketch pads, art pads, banners of paper, page markers, bookmarks and recipe cards containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; labeling tape; cover-up tape for paper; correcting tape for type; tape flags; easels; display and message boards, adhesive backed strips and geometrical shapes made from cardboard for attachment to surfaces; dry erase writing boards and

		writing surfaces; holders for stationery notes, notepads and tape flags; dispensers for tape flags and stationery notes for stationery use; ball point pens and highlighter pens containing tape flags; photo paper
3861083	10/12/10	Adhesive-backed paper pockets for attachment to surfaces; adhesive labels; adhesive-backed paper name badges; adhesive-backed craft paper

Each of the registrations listed in the preceding chart is valid and subsisting, and all but the last two are incontestable pursuant to 15 U.S.C. § 1065.

4. Applicant Bi-Silque-Artigos Para Casa e Escritorio, S.A. is a Portuguese corporation with a principal place of business at Avenida Da Praia, Esmoriz, 3880 Ovar, Portugal.

5. Applicant filed application Serial No. 77/405,947 (“the Application”) pursuant to 15 U.S.C. § 1126(d) on February 26, 2008, claiming a foreign filing date of January 30, 2008, for the mark EARTH-IT (“Applicant’s Mark”) for the following goods in Class 16: “office articles, in particular presentation boards, interactive presentation boards, dry erase writing boards and writing surfaces, dry erase boards for use with magnetic products, office combination boards comprised in part of dry erase boards and in part of bulletin boards, daily planners, desktop planners, markers, white board erasers, corkboard pushpins, presentation easels and flip chart pads,” and for the following goods in Class 20: “office furniture; bulletin boards.” The filing basis of the Application was later amended to 15 U.S.C. § 1126(e).

6. The Application was published in the *Official Gazette* on May 24, 2011. Opposer timely requested and received extensions of time until September 21, 2011 to file a Notice of Opposition.

7. Opposer has priority based on its prior use and registration of its mark POST-IT in the United States.

8. Opposer's mark POST-IT became famous long prior to Applicant's filing date or any priority date that Applicant may claim for Applicant's Mark.

9. Applicant's Mark is confusingly similar to Opposer's mark POST-IT. Applicant's mark is very similar to the mark POST-IT in sight, sound, meaning, and overall commercial impression. In particular, Applicant's Mark EARTH-IT and Opposer's mark POST-IT are comprised of a one-syllable terms followed by -IT. Moreover, 3M is committed to sustainable practices in connection with its formulation of POST-IT products, including but not limited to the use of recycled paper in many of 3M's POST-IT products. 3M's packaging and marketing of its POST-IT products have called attention to these and other sustainability efforts by 3M.

10. The goods in the Application are directly competitive with, or similar or related to, the goods for which Opposer uses and has registered its mark POST-IT.

11. Because the Application is unrestricted to any particular trade channel, Applicant's goods travel or will travel in the same channels of trade as Opposer's goods, and are or will be purchased and used by the same types of consumers who purchase and use Opposer's goods.

12. Opposer has not given Applicant permission or approval to use or register Applicant's Mark.

13. Applicant's Mark so resembles Opposer's mark POST-IT as to be likely, when used on or in connection with the identified goods of Applicant, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to mistakenly believe that the products Applicant intends to offer under Applicant's Mark are produced, sponsored, endorsed, or approved by Opposer, or are in some way affiliated, connected, or associated with Opposer or its POST-IT brand products.

14. Opposer would be damaged by registration of Applicant's Mark, which should be refused under 15 U.S.C. §§ 1052(d) and 1063.

15. Applicant's Mark is likely to cause dilution by blurring of Opposer's famous mark POST-IT, and registration should therefore be refused under 15 U.S.C. § 1125(c).


16. Registration of Applicant's Mark would be inconsistent with Opposer's rights in the mark POST-IT and would be damaging to Opposer.

WHEREFORE, Opposer prays that Application Serial No. 77/405,947 be rejected, and that registration of Applicant's Mark be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey Barber LLP, Account No. 50-3924/3MTM:034/SJH, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: September 21, 2011



William G. Barber
Susan J. Hightower
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ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing NOTICE OF OPPOSITION was served by first class mail on September 21, 2011 on counsel for the Applicant at the Correspondent address listed below:

David Ehrlich
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
New York, NY 10017-1822



CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of **MOTION TO SUSPEND OPPOSITION PENDING RESOLUTION OF CIVIL ACTION** to be served upon Opposer by depositing a copy thereof in the United States Mail postage prepaid on October 31, 2011 addressed as follows:

William G. Barber
Pirkey Barber LLP
600 Congress Ave., Suite 2120
Austin, TX 78701
UNITED STATES



Barbara A. Solomon